

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of : Attorney Docket No. 2006_0980A
Peter HEROLD et al. :
Patent No. 7,786,307 :
Issued August 31, 2010 :
AMINO ALCOHOL DERIVATIVES AND :
THEIR ACTIVITY AS RENIN INHIBITORS :

PETITION REGARDING PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 C.F.R. § 1.705(d), the Patentee hereby applies for patent term adjustment under 35 U.S.C. § 154(b) of 550 days. This Petition is being filed within two months of the Issue Date (August 31, 2010), as required by 37 C.F.R. § 1.705(d).

I. Fee

As required by 37 C.F.R. § 1.705(b)(1), this Petition is accompanied by the required fee of \$200.00.

II. Statement of the Facts Involved

A. Correct Patent Term Adjustment

The Issue Notification, which was mailed on August 11, 2010, indicated a Patent Term Adjustment of 430 days.

Patentee has calculated a Patent Term Adjustment of 550 days based on the following facts:

B. Relevant Dates

The above identified application has a 35 U.S.C. § 371 filing date of July 24, 2006.

The first Office Action, which was a Restriction Requirement, was mailed on March 21, 2008, resulting in a PTO delay of 179 days beyond the 14 months provided by 35 U.S.C. § 154(b).

A Response by the Patentee was filed April 21, 2008, within the 3 months provided by 35 U.S.C. § 154(b).

An Office Action was mailed June 24, 2008, within the 4 months provided by 35 U.S.C. § 154(b).

A Response by the Patentee was filed September 12, 2008, within the 3 months provided by 35 U.S.C. § 154(b).

A non-final Office Action was mailed December 26, 2008, within the 4 months provided by 35 U.S.C. § 154(b).

A response by the Patentee was filed April 27, 2009, resulting in a Patentee delay of 32 days beyond the 3 months provided by 35 U.S.C. § 154(b).

A final Office Action was mailed August 31, 2009, resulting in a PTO delay of 4 days beyond the 4 months provided by 35 U.S.C. § 154(b).

A response by the Patentee was filed November 30, 2009, within the 4 months provided by 35 U.S.C. § 154(b).

A Notice of Allowance was mailed December 11, 2009, within the 4 months provided by 35 U.S.C. § 154(b).

The Issue Fee was paid on March 11, 2010, and was submitted together with a Petition Regarding Patent Term Adjustment Under C.F.R. § 1.705(b), within the 3 months provided by 35 U.S.C. § 154(b).

A Decision on the Petition was mailed August 2, 2010.

The patent issued on August 31, 2010, resulting in a PTO delay of 51 days beyond the 4 months provided by 35 U.S.C. § 154(b).

Accordingly, the PTO adjustment based on delay under 35 U.S.C. § 154(b)(1)(A) is 234 days.

The 35 U.S.C. § 154(b)(1)(B) period for the instant application began on July 24, 2009 (three years after the filing date of July 24, 2006) and ended on the date of issuance (August 31, 2010). Thus, The 35 U.S.C. § 154(b)(1)(B) period running from July 24, 2009 until August 31, 2010 is 403 days.

There were 55 days (4 + 51) of PTO delay under 35 U.S.C. § 154(b)(1)(A) that overlap with the 35 U.S.C. § 154(b)(1)(B) period that should be excluded from the patent term adjustment calculation under the holding of *Wyeth v. Kappos*, 2010 U.S. App. Lexis 300.

There were 32 days of Patentee delay under 35 U.S.C. § 154(b)(2)(C).

Accordingly, the sum of the 35 U.S.C. § 154(b)(2)(B) delay (403 days) and 35 U.S.C. § 154(b)(2)(A) delay (234 days) less the overlap days (55 days) and less Patentee delay days (32 days) results in a PTA of **550 days**.

The PTA printed on the Issue Notification is only 430 days. It appears that the USPTO has reduced the total PTA by 120 days based on the Petition filed March 11, 2010. Patentee respectfully asserts that this reduction in PTA is in error, and should be corrected. Patentee refers to 37 C.F.R. § 1.704(e), which clearly states that submission of an application for patent term adjustment under § 1.705(b) will not be considered a failure to engage in reasonable efforts to conclude prosecution under 37 C.F.R. § 1.704(c)(10).

Patentee therefore respectfully requests reconsideration of the PTA calculation.

C. Terminal Disclaimer

The above-identified patent is not subject to a Terminal Disclaimer.

D. Reasonable Efforts

Any Patentee delays under 37 C.F.R. § 1.704 are set forth above. There were no other circumstances constituting a failure to engage in reasonable efforts to conclude processing of examination of the above-identified application, as set forth in 37 C.F.R. § 1.704.

Based upon the provisions of 37 CFR 1.705(d), and for the reasons provided in detail above, Patentee respectfully requests correction of the Patent Term Adjustment in the above-identified patent to **550 days**.

Respectfully submitted,

Peter HEROLD et al.

/Amy E. Schmid/

By 2010.09.22 15:29:55 -04'00'

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